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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,613	04/26/2001	Philip L. Taylor	MBX 034 CON (2)	9397

23579 7590 08/15/2003

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 09/842,613	Applicant(s) TAYLOR, PHILIP L.	
	Examiner Tae H Yoon	Art Unit 1714	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**TAE H. YOON**  
**PRIMARY EXAMINER**

Tae H Yoon  
Primary Examiner  
Art Unit: 1714

**ATTACHMENT TO ADVISORY ACTION**

Double patenting rejection is maintained since applicant failed to file a terminal disclaimer.

With respect to 35 U.S.C. 112, first paragraph, the rejection is maintained for reason of record and following response. Dr. Taylor's declaration states "I attest that, based on my experience as a researcher in PHA polyesters, a non-crystalline or an amorphous PHA polyester alone will crystallize and/or fuse at ambient temperatures to form a PHA polyester film". Thus, said statement is general in nature based on his experience, and one of the statements can be non-crystalline or an amorphous PHA polyester alone will crystallize at ambient temperatures (fusing is an optional feature) which would meet the example 1 of Marchessault et al (US'456). Of course, the examiner agrees with applicant in that an amorphous polymer **can** be crystallize, but it would require particular conditions in order to obtain a crystalline polymer.

Applicant points to examples 1 and 2, but the hard, tack-resistant coating properties are based on the composition comprising 90 wt% of PHA particles and 10 wt% of an acrylic film-forming polymer. The examiner believes that said 90 wt% of PHA particles would crystallize in said 10 wt% of an acrylic film-forming polymer and act as a reinforcing filler. Again, **there is no evidence that an amorphous PHA polyester alone forms a hard, tack-resistant coating at ambient temperature.** The example 1 of Marchessault et al teach that essentially non-crystalline (essentially amorphous in

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another words) particles of a PHA polymer forms a white film with little or no strength at room temperature.


With respect to Marchessault et al (US'456), the examiner believes that the recited "essentially non-crystalline particles of a PHA polymer" in Marchessault et al inherently meets the instant PHA polymer since said teaching can be "essentially amorphous polymer". The use of a latex in said example 1 would meets the invention since it would fuse at room temperature due to the presence of a film-forming latex.

With respect to Marchessault et al (US'456) and Miyagawa et al, see above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Tae H Yoon  
Primary Examiner  
Art Unit 1714

THY